

## REMARKS

### Summary

Claims 1-34 were pending and all of the claims were rejected in the Office action; Claims 29 and 31-34 have been cancelled; new Claims 35-38 have been added. Claims 3, 4, 6-17, 21-28 and 31-34 were rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 2, 18-20, 29 and 30 were rejected under 35 U.S.C. § 102(e). The Applicants respectfully traverse these rejections, based on the arguments presented below. After entry of this amendment, Claims 1-4, 6-28, 30 and 35-38 are pending. No new matter has been added.

### Rejections under 35 U.S.C. § 112, first paragraph

Claims 3, 4, 6-17, 21-28 and 31-34 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In making amendments in the paper submitted September 22, 2003, the Applicants relied on the Examiner's Office action of July 30, 2003, in which Claims 5 and 18 were objected to as claims dependent on a rejected base claim, but otherwise containing allowable subject matter. At that time, no question of enablement was raised.

The Examiner now asserts that:

The instant specification details two embodiments: (a) contents of remote controller panel are electrically changed via signals from the television and (b) contents of remote controller panel are changed via cards that are swapped. Claims 21 and 31 combine (a) and (b). While the instant specification teaches (a) and (b) separately, it doesn't detail a combination of them.

The Applicants respectfully traverse this rejection for two independent reasons: 1) The specification itself describes this arrangement, and: 2) The subject matter is incorporated in the original claims.

First, the Applicants respectfully call attention to the text in the original specification at page 4, lines 8-11 which specifically addresses an arrangement

meeting the requirements in the office action quoted above. See, also, page 16, lines 3-6:

The controller of the present invention is not limited to the above-described embodiments, and may be such that, for example, the above-described display sheets can be attached/detached on a thin display panel. In the case of only a display device, the controller may be used for selecting a channel, and when the controller is used for another function, a display sheet in accordance with each function may be attached.

This fully supports the arrangements claimed.

Second, original claims provide literal support for themselves. See *In re Anderson*, 471 F.2d 1237, 1238-39, 176 USPQ 331, 332 (CCPA1973) (unamended original claim is a part of the original disclosure).

However, in order to expedite the prosecution of this patent, and to obviate the possibility that the specification may be held not to sufficiently support the claims, the specification has been amended to incorporate subject matter from the original claims. Specifically, the specification amendment incorporates the subject matter recited in original Claim 5 as well as the subject matter of original Claims 1 and 2 upon which it depends. Subject matter from original Claim 5 is now incorporated in new Claim 35. Incorporation of subject matter from the original claims in a specification amendment does not constitute the introduction of new matter.

For at least these reasons, the Applicants respectfully submit that Claims 3, 4, 6-17, 21-28 and 31-34 as presented in the paper submitted September 22, 2003, should not have been rejected.

However, extensive, but not substantive, amendments to the claims were necessitated by the Examiner's previous Office action of July 30, 2003 in order to

place the application in a condition for allowance. Under the present circumstances, however, and in order to clarify the prosecution history, the Claims have been amended in order to return, as much as is possible given the procedural requirements of the patent examination process, to a *status quo ante* the Amendment of September 22, 2003. The subject matter of cancelled Claim 5 has been re-introduced in Claim 35, and additional claims are introduced to set forth aspects of the invention as described in the specification. Thus, the preponderance of the following remarks will address the Office action of July 30, 2003.

**Rejections under 35 U.S.C. § 103 (a) (Office action of July 30, 2003)**

Claims 1-4, 6-17, 19-23 and 25 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kurita (U.S. 5,353,016: "Kurita") in view of Madill et al. (U.S. Des 363932: "Madill"). The Examiner concedes that Kurita "fails to teach that the changeable card is above the sensor input" (Office action page 3, last paragraph). However in rejecting Claims 1, 2 and 20, the Examiner asserts that there is obvious motivation "to employ the old and well-known overlaid card of Madill instead of the underlying card of Kurita because the clear, touch-sensitive screen in Kurita is potentially more expensive and fragile than one that does not have to be clear".

Claim 1 recites, *inter alia*,

an input mechanism;

a display member that displays an input portion of said input mechanism, the input portion including input items, display of one of the input portion and at least one input item being changeable, said display member being overlaid on said input mechanism ....

In the Response to Arguments (Office action, page 7), the Examiner re-asserts that there is no "'functional' difference between having a keypad above [overlaid] and below the keypad." There is no doubt that there is a physical difference, and if this were a matter of anticipation, the Applicants respectfully

submit that that physical difference would be determinative as to patentability. It is equally true when a reference is used in combination with another reference for an obviousness rejection. As such, the two references do not teach all of the elements of the claims to which they have been applied, and the Applicants respectfully submit that the Examiner has not set forth a *prima facie* case of obviousness.

Further, the Examiner discounts the fact that Madill has holes for buttons "because Kurita doesn't have buttons". Madill is a design patent, and cannot be relied upon for anything not shown in the drawings, which constitute the complete disclosure. In the drawings, an exploded view is shown, having a card with holes, the holes exposing a surface or buttons through the card. The card itself and the holes therein are shown in solid lines. Solid lines represent the novel ornamental design which is the teaching and the metes and bounds of the design patent. Since the device is shown in an exploded view, the card will be attached to the surface of the remainder of the device such that the specific areas of a surface underneath the card, or buttons, are exposed. As such, the card with holes is not overlaid on the input mechanism (the buttons or the area exposed by the holes in the card), and does not even constitute an equivalent to an element in the claimed invention.

Any motivation to modify the prior art references must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed Cir. 1995); *In re Gorman*, 933 F.2d 982, 986-87, 18 USPQ2d 1885, 1888, (Fed. Cir. 1991). ("When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant. [Citations omitted] . . . The extent to which such suggestion must be explicit in, or may be fairly inferred from, the

references, is decided on the facts of each case in the light of the prior art and its relationship to the applicants' invention.").

The input buttons or the areas exposed through the holes in the card taught by Madill are not protected by the card. But, the Examiner has asserted that an advantage of the display member in arrangement taught by the Applicants may be that it avoids the clear touch sensitive screen of Kurita, which "is potentially more expensive and fragile than one that does not have to be clear", and that this is the motivation to combine the teachings. But, card as taught by Madill must have holes. Using a card without holes makes Madill inoperative, as the individual buttons or areas beneath the card cannot be actuated and, if the card with holes is applied to Kurita, the touch screen would not be protected in the areas where the input was made, thus not having the advantages cited by the Examiner. Therefore there is no motivation, and certainly no suggestion in the references, to use the card with holes as taught by Madill as a changeable element overlaid on the touch screen taught by Kurita. The Applicants respectfully submit that any motivation to combine and modify the teachings of the references that the Examiner may find arises solely from the arrangement disclosed by the Applicants' specification and that the Examiner has not made out a *prima facie* case of obviousness with respect to independent Claims 1 and 20.

Claims 2-4, 6-19, 21-28, 30 and 35-38 are allowable, without more, as claims dependent directly or indirectly on Claims 1 and 20.

**Rejections under 35 U.S.C. § 102 (e) (Office action of November 26, 2003)**

Claims 1, 2, 18-20, 29 and 30 were rejected under 35 U.S.C. § 102 (e) as being anticipated by Kuhn et al. (U.S. 6,553,345:"Kuhn").

Kuhn is directed towards a remote control unit which supports multi-modal dialog with the user. Specifically the reference is directed towards a remote

control unit having a microphone accepting natural language speech input. One embodiment also includes a screen on which the user may view prompts or make selections by pen input or tapping.

The Examiner points to column 4, lines 10-22 of the reference and Fig. 1 thereof as evidence of anticipation. The Applicants respectfully submit that nothing in the specifically cited information or in the remainder of the reference suggests that the display member is overlaid on the input member as in the arrangement of Claim 1.

Claim 20 recites, *inter alia*, a display disposed in the case, the display member overlaid on the input mechanism when in an operational position.

The display shown in Fig. 1 of Kuhn may be touch sensitive or tap sensitive (Kuhn, column 2, lines 54-55) but there is no description of its structure, and it therefore cannot be said to teach the arrangement of Claim 20.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears Roebuck & Co.* 722 F.2d 1542 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Since the reference cited does not meet this test, a *prima facie* case of anticipation has not been made out, and Claims 1 and 20 are allowable.

Claims 2-4, 6-19, 21-28, 30 and 35-36 are allowable, without more, as claims dependent directly or indirectly on Claims 1 and 20.

### **Claims with Allowable Subject Matter**

The Office action of July 30, 2003 found that Claims 5 and 18 contained allowable subject matter, but the claims were objected to on the basis that they depended on a rejected base claim. Applicants note that an amended Claim 5 has been re-presented as Claim 35, which is dependent on Claim 1. The Applicants respectfully submit that Claim 35 remains independently patentable.

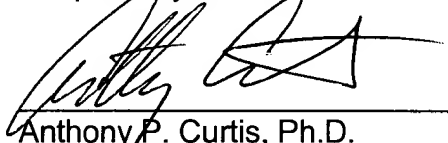
### **Conclusion**

Claims 1-4, 6-28, 30 and 35-38 are pending after entry of this amendment.

For at least the reasons given above, the Applicants respectfully submit that the pending claims are in condition for allowance and request that a Notice of Allowance be promptly issued.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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